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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,405	05/29/2002	Jean-Pierre Benoit	03715.0110	3630

7590 11/04/2004

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EXAMINER

TRAN, THAO T

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/069,405	Applicant(s) BENOIT ET AL. S.C.	
	Examiner Thao T. Tran	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 23, 2004 has been entered.
2. Claims 1-40 are currently pending in this application.

Claim Objections

3. In view of the prior Office action of January 20, 2004, the objection to claim 3 has been withdrawn due to the Amendments made thereto.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the newly added limitation, “dynamic stirring”, which has no proper support in the specification as originally disclosed. The instant specification, page 13, discloses the use of “magnetic stirring” and “mechanical stirring”. However, the phrase “dynamic stirring” embraces more than just “magnetic stirring” or “mechanical stirring”.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-31 and 33-40 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/13799.

WO ‘799 teaches a process for microencapsulating an active agent (principle) by coacervation, the process consisting of dissolving a polymer in an organic solvent, which contains the active substance; mixing the polymer/active agent solution (first phase) with another liquid (second phase) using a static mixer; the organic solvent comprising ethyl acetate and an alcohol or a ketone of 1 to 3 carbon atoms; the second phase liquid containing a surfactant, polyvinyl alcohol. The mixture is quenched at 0-4°C with water or an aqueous solution containing a surfactant as that in the second phase liquid (see Figures 1-3; page 22, last paragraph to page 23, 1st paragraph; page 26, 2nd paragraph; claims 1-49). The stirring is at a

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speed of 700 rpm and the particle size is 25 microns (see page 55, 1st paragraph; page 59, Example 15).

Since the reference uses a static mixer, a mechanical stirring, this would satisfy the requirement for a dynamic stirring.

With respect to the concentration of the surfactant in the curing agent, WO '799 teaches a concentration of 01 to 10 wt% (see page 19, 1st paragraph), which appears to read on the instantly claimed ranges. WO '799 further teaches the polymer having a weight-average molecular mass of between 10,000 and 90,000 g/mol (see page 17, 1st paragraph).

WO '799 further teaches the polymer to be 75:25 PLGA (see page 16, ln. 24; page 35, ln. 7-8). Although the reference does not specifically teach the polydispersity index or the relative dielectric permittivity, since the reference teaches the same polymer, the reference's polymer would inherently have the same properties as those of the presently claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO '799 as applied to claims 1 and 10 above.

WO '799 is as set forth in claims 1 and 10 above and incorporated herein.

WO '799 further teaches that the solvent system is optimal at 0-4°C (see page 28, ln. 13).

Therefore, although the reference does not teach the coacervation temperature being equal to -4°C , it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the coacervation temperature would have been adjusted to -4°C in order to bring forth maximal benefits attendant therewith. This is because Applicants have not disclosed the advantages of this temperature over other temperatures. And since WO '799 teaches that the coacervation temperature would be optimal at $0-4^{\circ}\text{C}$, the coacervation temperature taught by WO '799 would also include temperatures outside $0-4^{\circ}\text{C}$.

Response to Arguments

10. Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive.

Throughout the Remarks, Applicants contend that the reference of WO '799 differs from the presently claimed invention because the reference teaches a process of emulsion using a static mixer, thus not a dynamic stirring. However, as defined by Applicants in the Remarks, dynamic stirring includes mechanical stirring. Since WO '799 uses a static mixer, which is also a mechanical stirring, WO '799 does teach the presently claimed invention.

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
November 01, 2004

Thao Tran
THAO T. TRAN
PATENT EXAMINER